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Application No. 10/804,495

**REMARKS**

Claims 21-32 are pending in the application with claim 27 amended herein.

Claims 27-32 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Without admitting to the propriety of the rejection, Applicant herein amends claim 27, remedying the allegedly indefinite terms. Applicant requests withdrawal of the rejection in the next Office Action.

Claims 27-30 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hays ('477). Applicant requests reconsideration.

Amended claim 27 sets forth a method of forming a phase change ink that includes, among other features, reacting one or more alcohols with one or more isocyanates. The alcohols contain fused-ring alcohols which include at least three fused rings and a product of the reacting comprises a non-polymeric urethane resin. The method involves including the resin in a phase change ink composition. Pages 2-3 of the Office Action alleges that Hays discloses each and every limitation of claim 27. Applicant traverses.

Page 2 of the Office Action states that "one would reasonably expect the ink of Hays to inherently be a phase change ink." Applicant previously asserted on pages 7-8 of the Response to September 28, 2006 Office Action that mere disclosure of using the Hays oligomeric aromatic dispersant in oil-based printing inks does not constitute disclosure of the claimed method setting forth including a non-polymeric urethane resin in a phase change ink composition. "The mere fact that a certain thing may result from a given set

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of circumstances is not sufficient to establish inherency." In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (citations omitted) (emphasis in original); MPEP § 2112.

Further, "[i]n relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added); MPEP § 2112. The Office Action does not reference any evidence in-fact establishing that "oil-based printing inks" are inherently "phase change inks." The Office Action also fails to provide any technical reasoning that reasonably supports the determination that oil-based printing ink is inherently phase change ink. Instead, the Office Action merely contains a bare, conclusory determination that the ink disclosed in Hays is inherently a phase change ink. Consequently, the Office Action is defective as failing to establish by substantial evidence disclosure in Hays of each and every element set forth in claim 27. As a result, Hays does not anticipate claim 27.

In addition, page 3 of the Office Action alleges that Hays discloses reaction of an isocyanate-functional oligomer with Hays' rosin-based capping agents, such as hydroabietyl alcohol. However, the Office Action fails to establish with substantial evidence the disclosure of an isocyanate-functional oligomer in Hays. Review of the various structural formulas for the oligomer after capping, such as in column 4 and elsewhere, fails to provide support for the Office's allegation that the oligomer includes an isocyanate functional

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group. Instead, it is well known that the --NCO isocyanate group in the reactants converts to the --NHCO-- carbamate group appearing in the various structural formulas throughout Hays. Notably, the nitrogen-carbon double bond present in the isocyanate group is not shown in the structural formulas representing the Hays oligomeric reaction product after capping. An indication of this conversion is further evidenced at least by column 4, lines 53-57 of Hays.

Applicant reiterates from the Response to September 28, 2006 Office Action that the only disclosure in Hays of the claimed fused-ring alcohols with at least three fused rings pertains to description of the rosin-based capping agents in column 7, lines 23-26. Also, the only description of a reaction using the rosin-based capping agents pertains to capping the oligomer after completion of the oligomerization reaction. In other words, the carbamate groups shown in the Hays structural formulas are already present in the oligomer during the capping reaction. The Office does not now and has not previously referenced evidence in Hays that it discloses an isocyanate-functional oligomer. Consequently, the Office Action is defective as failing to establish by substantial evidence disclosure in Hays of each and every element set forth in claim 27. As a result, Hays does not anticipate claim 27.

Claims 21-32 stand provisionally rejected for obviousness-type double patenting over certain claims corresponding to patent applications listed on page 4 of the Office Action. Applicant asserts that all pending claims are otherwise allowable and requests withdrawal of the provisional obviousness-type double patenting rejection.

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Claims 21-32 stand rejected for obviousness-type double patenting of claims 13 and 14 of US Patent Application No. 10/918,619. Applicant requests reconsideration. With the issuance of US Patent No. 7,211,131 from Application No. 10/918,619, claims 13 and 14 of the application forming the basis of the double patenting rejection issued as claims 13 and 14 of the patent. Pursuant to MPEP 804(II)(B)(1)(b), the circumstances of the present application require a showing of two-way obviousness.

Largely, the rejected claims of the present application were originally filed in the priority application on September 5, 2000, well before the filing of claims 13 and 14 forming the basis of the double patenting rejection. Due to the Office's restriction of the original claims, the present divisional application was filed on March 18, 2004, also before the filing of claims 13 and 14. Due to the Office's administrative delay, claims 13 and 14 issued before the rejected claims. Applicant asserts that the Office Action does not establish two-way obviousness of the rejected claims and claims 13 and 14. The Office Action fails to establish any basis for a conclusion that claims 13 and 14 are not patentably distinct over the rejected claims. At least for such reason, Applicant requests withdrawal of the double patenting rejection in the next Office Action.

Applicant herein establishes adequate reasons supporting patentability of claims 21-32 and requests allowance of all claims in the next Office Action.

Respectfully submitted,

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By: J.E. Lake  
James E. Lake  
Reg. No. 44,854